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MAILED
MAY 09 2012
OFFICE OF PETITIONS

In re Application of	:	
Pekka Lonka	:	
Application No. 10/692,273	:	DECISION ON SECOND RENEWED
Filed: October 23, 2003	:	PETITION PURSUANT TO
Attorney Docket Number: 297,-	:	37 C.F.R. § 1.183 AND
008681-US (REI)	:	RENEWED PETITION PURSUANT TO
Title: MOBILE COMMUNICATIONS	:	37 C.F.R. § 1.137(b)
DEVICE WITH A CAMERA	:	

This is a decision on the second renewed petition pursuant to 37 C.F.R. § 1.183,¹ filed March 19, 2012, requesting the waiver of 37 C.F.R. § 1.63(a)(1).² This is also a decision on the concurrently filed renewed petition pursuant to 37 C.F.R. § 1.137(b)

The renewed petition pursuant to 37 C.F.R. § 1.137(b) is **GRANTED**.

The second renewed petition pursuant to 37 C.F.R. § 1.183 is **GRANTED**.

The present application No. 10/692,273 is for the reissue of U.S. Patent number 6,308,084, which issued on October 23, 2001, from application number 09/325,025.

Both a notice of appeal and a "Pre-Appeal Brief Request for Review" were submitted on December 11, 2006. The above-identified application became abandoned for failure to reply in a timely manner to the "Notice of Panel Decision from Pre-Appeal Brief Review," mailed January 23, 2007, which set a one-month

¹ See MPEP § 603: "[w]hen an inventor who executed the original declaration is refusing or cannot be found to execute a required supplemental declaration, the requirement for that inventor to sign the supplemental declaration may be suspended or waived in accordance with 37 CFR 1.183."

² A non-final Office action mailed on March 29, 2006 indicated that the reissue declaration that was present on filing was defective.

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period for response. No response was received, and no extension of time under the provisions of 37 C.F.R. § 1.136(a) was requested. Accordingly, the above-identified application became abandoned on February 24, 2007. A notice of abandonment was mailed on January 7, 2008.

RELEVANT REGULATIONS AND PORTION OF THE MPEP

37 C.F.R. § 1.63(a)(1) sets forth, *in toto*:

(a) An oath or declaration filed under § 1.51(b)(2) as a part of a nonprovisional application must:

(1) Be executed, i.e., signed, in accordance with either § 1.66 or § 1.68. There is no minimum age for a person to be qualified to sign, but the person must be competent to sign, i.e., understand the document that the person is signing;

37 C.F.R. § 1.183 sets forth, *in toto*:

In an extraordinary situation, when justice requires, any requirement of the regulations in this part which is not a requirement of the statutes may be suspended or waived by the Director or the Director's designee, sua sponte, or on petition of the interested party, subject to such other requirements as may be imposed. Any petition under this section must be accompanied by the petition fee set forth in § 1.17(f).

37 C.F.R. § 1.175(a) sets forth, *in toto*:

(a) The reissue oath or declaration in addition to complying with the requirements of § 1.63, must also state that:

(1) The applicant believes the original patent to be wholly or partly inoperative or invalid by reason of a defective specification or drawing, or by reason of the patentee claiming more or less than the patentee had the right to claim in the patent, stating at least one error being relied upon as the basis for reissue; and

(2) All errors being corrected in the reissue application up to the time of filing of the oath or declaration under this paragraph arose without any deceptive intention on the part of the applicant.

PROCEDURAL HISTORY AND ANALYSIS

A petition pursuant to 37 C.F.R. § 1.181 was filed on January 15, 2008, and was dismissed via the mailing of a decision on July 14, 2008.

An original petition pursuant to 37 C.F.R. § 1.137(b) was filed on July 31, 2008, along with an amendment, the petition fee, and the proper statement of unintentional delay. The original petition pursuant to 37 C.F.R. § 1.137(b) was dismissed via the mailing of a decision on March 10, 2009.

A petition pursuant to 37 C.F.R. § 1.183 and a renewed petition pursuant to 1.137(b) were concurrently filed on September 9,

2009. The former was dismissed and the latter was granted via the mailing of a single decision on May 26, 2010, which indicated, *in pertinent part*:

This petition cannot be granted, as Petitioner has not asserted, much less established, the existence of an extraordinary situation such that justice requires the waiver of the requirement that the supplemental reissue declaration be executed by the sole inventor.

On renewed petition, Petitioner will need to assert the existence of an extraordinary situation, such that justice requires the waiver of the requirement that the sole inventor must execute the supplemental reissue declaration.

Assuming arguendo that Petitioner has asserted the existence of an extraordinary situation such that justice requires the waiver of the requirement that the supplemental reissue declaration be executed by the sole inventor, this petition cannot be granted as the record does not support a finding that this assertion has been established. A discussion follows.

While Rule 1.47(b) is not directly applicable to the current set of facts, it does provide a similar method for rectifying situations involving the refusal of an inventor to execute a declaration. As such, a Rule 1.47(b) analysis will be applied to determine whether an extraordinary situation is present, such that justice requires the waiver of Rule 1.63(a)(1). The applicable elements are as follows:

- (1) a statement of the last known address of the sole inventor;
- (2) proof that either:
 - (a) a copy of the application was sent or given to the sole inventor for review and proof that he/she has refused to sign, or;
 - (b) proof that diligent efforts have been made to locate the sole inventor;
- (3) proof that the Rule 47(b) (sic) applicant has sufficient proprietary interest in the subject matter to justify the filing of the application;
- (4) proof of irreparable damage, and;
- (5) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116 and 37 C.F.R. § 1.63.

With this petition pursuant to 37 C.F.R. § 1.183, Petitioner has included a portion of the petition fee,³ the last known address of the non-signing sole inventor,⁴ proof that a complete copy of the application was sent to the last known address of the non-signing

³ \$200 was submitted. The additional \$200 was charged to Deposit Account No. 16-1350 on May 25, 2010.

⁴ Statement of facts submitted with the original petition, section II.

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sole inventor,⁵ and proof that he has refused to execute the supplemental reissue declaration.⁶

Requirements (1) - (3) above have been satisfied.

Regarding the fourth requirement, no proof of irreparable damage has been submitted.⁷ A statement by Rule 47(b) (sic) applicant that the filing is necessary to preserve the rights of the parties would be sufficient.

Regarding the fifth requirement, a supplemental reissue declaration has not been located in the electronic file. On renewed petition, Petitioner must include a supplemental reissue declaration that has been executed in accordance with MPEP §§ 324 and 409.03(b).

May 26, 2010 decision on original petition pursuant to 37 C.F.R. § 1.183, pages 3-5.

A renewed petition pursuant to 37 C.F.R. § 1.183 was filed on July 26, 2010 which was dismissed via the mailing of a decision on March 14, 2011, which indicated the fourth requirement that was set forth on the fourth page of the decision of May 26, 2010 had been satisfied, to date, requirements (1) - (4) had been satisfied, and the fifth requirement remained unsatisfied.

The above-identified application became abandoned for failure to reply in a timely manner to the decision of March 14, 2011, which set a period for reply of two months. No response was received, and no extensions of time under the provisions of 37 C.F.R. § 1.136(a) were requested. Accordingly, the above-identified application became abandoned on May 15, 2011.

Regarding the renewed petition pursuant to 37 C.F.R. § 1.137(b):

A grantable petition pursuant to 37 C.F.R. § 1.137(b) must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in 37 C.F.R. § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The

⁵ Id. at III (5-10)

⁶ Id. at III (8 and 10).

⁷ See MPEP § 409.03(g).

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Commissioner may require additional information where there is a question whether the delay was unintentional, and;

- (4) Any terminal disclaimer (and fee as set forth in 37 C.F.R. § 1.20(d)) required pursuant to paragraph (d) of this section.

Petitioner has included the petition fee. Moreover, the amendment that was submitted on September 9, 2009 has been considered by the Examiner. A communication from the Examiner has been included with this decision.

The first, second, and third requirements of Rule 1.137(b) have been satisfied. The fourth requirement of Rule 1.137(b) is not applicable, as a terminal disclaimer is not required.⁸

Regarding the second renewed petition pursuant to 37 C.F.R. § 1.183:

With this second renewed petition pursuant to 37 C.F.R. § 1.183, Petitioner has submitted a statement that is being construed to represent and assertion of the existence of an extraordinary situation such that justice requires the waiver of the requirement that the supplemental reissue declaration be executed by the sole inventor.⁹

As set forth above, Petitioner has previously submitted a statement of the last known address of the non-signing inventor, proof that a complete copy of the reissue application was sent to the last known address of the non-signing sole inventor, proof that he has refused to execute the reissue declaration, and proof of irreparable damage.

With this second renewed petition pursuant to 37 C.F.R. § 1.183, Petitioner has established the applicant has sufficient proprietary interest in the subject matter to justify the filing of the application via the establishment of the right of the purported Assignee to take action, pursuant to 37 C.F.R. § 3.73, in that both a statement under 37 C.F.R. § 3.73(b) and the written consent to the reissue by the assignee(s) and any inventor having an ownership interest have been included with this renewed petition.

⁸ See Rule 1.137(d).

⁹ Second renewed petition pursuant to 37 C.F.R. § 1.183, page 1.

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It follows that Petitioner has established the existence of an extraordinary situation where justice requires waiver of the rules.

This second renewed petition pursuant to 37 C.F.R. § 1.183 is granted to the extent that the supplemental reissue declaration of July 26, 2010 may be entered, despite the fact that the requirement that the sole inventor must sign the declaration has not been satisfied.

The Technology Center will be notified of this decision.

Petitioner may find it beneficial to view Private PAIR within a fortnight of the present decision to ensure that the revival has been acknowledged by the Technology Center in response to this decision. It is noted that all inquiries with regard to any failure of that change in status should be directed to the Technology Center where that change of status must be effected - **the Office of Petitions cannot effectuate a change of status.**

Telephone inquiries regarding *this decision* should be directed to Senior Attorney Paul Shanoski at (571) 272-3225.¹⁰ All other inquiries concerning examination procedures or status of the application should be directed to the Technology Center.



Anthony Knight
Director
Office of Petitions

Encl. Miscellaneous Office Communication

¹⁰ Petitioner will note that all practice before the Office should be in writing, and the action of the Office will be based exclusively on the written record in the Office. See 37 C.F.R. § 1.2. As such, Petitioner is reminded that no telephone discussion may be controlling or considered authority for Petitioner's further action(s).

**UNITED STATES DEPARTMENT OF COMMERCE****U.S. Patent and Trademark Office**

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APPLICATION NO./ CONTROL NO.	FILING DATE	FIRST NAMED INVENTOR / PATENT IN REEXAMINATION	ATTORNEY DOCKET NO.
10/692,273	23 October, 2003	LONKA, PEKKA	879A.0150.U1 (US)

Harrington & Smith, Attorneys At Law, LLC 4 Research Drive, Suite 202 Shelton, CT 06484		EXAMINER	
		DANH LE	
		ART UNIT	PAPER
		2617	20120508

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner for Patents

The Reissue Application 10/692,273 is now in condition for allowance since the application was corrected all the defects by Amendment of Reissue Application under 37 CFR& 1.173, Certified Copy of Priority Document (FI 981274) filed on 09/09/2009 and Oath and Declaration filed on 07/26/2010.

/Danh C. Le/
Primary Examiner. AU 2617.

5/8/12